

**Amendment in Response to Office Action mailed May 12, 2008
U.S. Patent Application No. 09/801,958**

REMARKS

Reconsideration of this Application is respectfully requested in view of the foregoing amendment and the following remarks. Claims 21 and 23-38 were pending in this Application. Claims 21, 28 and 33 have been amended. Accordingly, claims 21 and 23-38 are presently under examination. Support for the amendments may be found, for example, in the original claims, and in the specification at page 3 lines 20-33 and page 12 line 8 through page 15 line 18. No new matter has been introduced by any of the requested amendments. For the reasons set forth below, Applicant respectfully submits that all claims pending herein are in condition for Allowance.

In the Office Action:

- Claims 21-35 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over U.S. Patent No. 6,931,657 to Marsh (“Marsh”) in view of U.S. Patent No. 5,886,995 to Arsenault et al. (“Arsenault”).
- Claims 36 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Marsh and Arsenault in view of U.S. Patent No. 6,418,424 to Hoffberg et al. (“Hoffberg”).

Applicant respectfully traverses these rejections, for the reasons set forth below.

Obviousness Rejection over Marsh in view of Arsenault

Claims 21-35 and 38 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Marsh in view of Arsenault. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

Marsh Fails to Teach or Suggest the Claimed Invention

The presently claimed invention recites systems and methods for recording a particular program, comprising: (a) receiving program information comprising a plurality of program events, wherein each program event is associated with a set of available content streams; (b)

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providing a user option to select a desired subset of the set of available content streams associated with the particular program event for recording, wherein the subset excludes at least one available content stream from the associated set of available content streams; and (c) receiving a user command or user input indicating the desired subset of available content streams for recording. *See* claims 21, 28 and 33, and their respective dependent claims. Claim 21 further requires that a storage device be configured to store the program information, and that a processor is configured to provide the user option and receive user input. *See* claim 21.

The Office contends that Marsh teaches a selectable recording device to record a particular program. Office Action at page 2. In particular, the Office contends that Marsh teaches the claimed systems and methods, because:

as noted in col. 5/line 25 to col. 6/line 8, Marsh shows an example of which subset or identifiable characteristic (content segments – meaning a portion of a particular program containing a plurality of content streams) that can be found in the EPG database to include or exclude for recording, for example, selectively identifying a show with Ms. Julia Roberts but not guest appearances on talk shows and the like etc.; and further as noted in col. 7/lines 40-61, closed caption text or supplemental information associated with a program and/or separate audio program for English can also be identified for recording or opt out ...

Office Action at pages 2-3. Applicant respectfully disagrees.

Contrary to the assertions in the Office Action, Marsh does not teach the claimed systems or methods, either in the cited columns or elsewhere. Marsh teaches methods and arrangements for use in selecting television and multimedia programs for recording, in which an intelligent content agent **108** may automatically record a particular program based on its monitoring of the types of programs that a viewer watches. Marsh at Abstract, col. 5, lines 1-25 through col. 7, line 61. The monitoring and selection of programs can be based on information found in an EPG such as a particular actor's appearance in a program, or can be based on monitoring of closed caption text for certain terms such as "Major League Baseball" during a program. Marsh at col. 5, lines 25-49 and col. 7, lines 40-61.

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As an initial matter, the Office Action does not sufficiently disclose how the elements of the claims are met, e.g., it is not explained which elements of Marsh correspond to the claimed program information, programs, available content streams or user inputs. Paramount to any grounds of rejection is an explanation of how the elements of the claim are described by a cited reference, but such explanation has not been provided with respect to each element of the claims.

The Office apparently equates the television programs of Marsh with the claimed available content streams, for example by discussing the decision to record a “show with Ms. Julia Roberts” but not “guest appearances on talk shows” as “select[ing] a desired subset of set of available content streams.” Office Action at page 3. This equation is further supported by the Office’s argument that the user’s selection (or opting out) of various programs to record is the same as the claimed receipt of user input indicating the desired subset of available content streams for recording. Office Action at page 3. However, the Office fails to explain what elements of Marsh equate to the other claim limitations, and the Office’s comparison breaks down at this point. Following the Office’s logic, if a user’s selection of the movie Pretty Woman for recording is equivalent to user input indicating a desired subset of available content streams, then the movie Pretty Woman is the desired subset of the set of available content streams associated with the particular program event. What then are the other available content streams? And what is the particular program event with which they are associated? What is the program information? What are the other sets of available content streams associated with the other programs in the plurality of programs? All of these questions remain unanswered by the Office’s rejection, and therefore the rejection is improper because it fails to show that each and every limitation of the claimed invention is taught or suggested by the art.

If the Office did not intend this interpretation of Marsh, and the television programs of Marsh equate to the claimed programs, then the rejection is still improper, because Marsh fails to teach the claimed available content streams, and the selection of a desired subset of available content streams for recording. The presently claimed systems and methods are directed at permitting a user to select a subset of the “available content streams” associated with a particular

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program event for recording. For example, if a user of the claimed system wanted to record a show with Ms. Julia Roberts, as in the Marsh system, the show is the particular program event for recording, e.g., the movie Pretty Woman. The movie is associated with a set of available content streams, for example an English surround sound audio stream, an English stereo audio stream, a Spanish audio stream, and a video stream. The system provides a user option to select a desired subset of the available content streams while excluding at least one of the content streams, and also receives user input indicating the desired subset. Depending on the user's preferences, the desired subset can vary. For example, a Spanish-speaking user might select the Spanish audio stream and the video stream, a user having a surround sound system might select the English surround sound audio stream and the video stream, and a deaf user might select only the video stream. The selection of the desired subset prevents unnecessary content stream recording and reduces the storage requirements.

Thus, as presently claimed, a user selects a subset of the available content streams associated with a particular program event for recording. The Marsh system does not teach, disclose or suggest this. Marsh teaches recording an entire program, and does not teach the recording of only certain content streams associated with a program event. Thus, the Marsh system would record the entire set of content streams associated with Pretty Woman, including the English surround sound audio stream, the English stereo audio stream, the Spanish audio stream, and the video stream. Thus, for the same program event, the user of the Marsh system would have increased storage requirements, because unnecessary content streams have been recorded.

Marsh thus fails to teach receiving program information comprising a plurality of program events, wherein each program event is associated with a set of available content streams, providing a user option to select a desired subset of the set of available content streams associated with the particular program event for recording, wherein the subset excludes at least one available content stream from the associated set of available content

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streams, and receiving a user command or user input indicating the desired subset of available content streams for recording, as required by all of the pending claims.

Arsenault Fails to Supplement the Deficiencies of Marsh

The Office contends that Arsenault teaches the association of a set of available content streams with a program event, at col. 5, lines 36-64 and col. 27, lines 17-33, and that “additional program information and services related to broadcast resources and bitstreams are available for transmission as the user receives all or portions (segments) of the simultaneous programming to be broadcast over a number of broadcast resources.” Office Action at pages 3-4. Applicant respectfully disagrees that Arsenault supplements the deficiencies of Marsh.

Contrary to the assertions in the Office Action, Arsenault does not teach the claimed invention, whether in the cited columns or elsewhere. Arsenault teaches a transmission distribution system which conserves bandwidth by consolidating the broadcast of simultaneous common programming from a number of different resources onto a lesser number of broadcast resources by using a unique mapping scheme. Arsenault at Summary (col. 5, lines 25-64). Arsenault also describes prioritizing certain programs during certain time slots, using dynamic mapping methods. Arsenault at col. 27, lines 17-33. Thus, Arsenault is directed to conserving broadcast resources by eliminating or reducing duplicate transmissions.

As described above, the presently claimed systems and methods are directed at permitting a user to select a subset of the “available content streams” associated with a particular program event for recording. Each program event is associated with a separate set of available content streams. The selection of the desired subset prevents unnecessary content stream recording and reduces the storage requirements. For example, if a user of the claimed system wanted to record a live sporting event such as the Superbowl, the user is provided with the option to select available content streams, for example an English audio stream, a Spanish audio stream, a regular definition video stream, and a high definition video stream. The system provides a user option to select a desired subset of the available content streams while excluding at least one of the content streams, and also receives user input indicating the desired subset. Depending on the

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user's preferences, the desired subset can vary. For example, a Spanish-speaking user might select the Spanish audio stream and the high definition video stream, and an English-speaking user might select the English audio stream and the regular definition video stream. The selection of the desired subset prevents unnecessary content stream recording and reduces the storage requirements.

The Arsenault system does not teach, disclose or suggest this. Arsenault teaches the broadcast transmission of entire programs, and the reduction in the amount of duplicate program events being transmitted, for example it reduces the number of duplicate program events for live sporting events such as the Superbowl. For example, the Arsenault system is designed to transmit only one program event for the Superbowl program over the broadcast resources, while mapping the program event to appear simultaneously on multiple viewer channels, for example Fox Television, the NFL Network, and ESPN. Arsenault does not teach the selection of only certain content streams associated with a program event. Arsenault selects an entire program event for transmission, and merely eliminates duplicates of that program event. Thus, when Arsenault transmits, it transmits the entire set of content streams associated with the particular program event, including the English audio stream, the Spanish audio stream, the regular definition video stream, and the high definition video stream, and does not teach reducing the set of content streams associated with a particular program event. Thus, for the user recording the program event, there is no difference between the Marsh and Arsenault systems, and the user of the Arsenault system would have increased storage requirements as compared to the claimed invention, because unnecessary content streams have been recorded.

Thus, Arsenault fails to teach receiving program information comprising a plurality of program events, wherein each program event is associated with a set of available content streams, providing a user option to select a desired subset of the set of available content streams associated with the particular program event for recording, wherein the subset excludes at least one available content stream from the associated set of available content

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streams, and receiving a user command or user input indicating the desired subset of available content streams for recording, as required by all of the pending claims.

In addition, a prima facie case of obviousness has not been established because the Office has not provided any support for the conclusion that there existed at the time of the invention an apparent reason to modify the device of Marsh in the manner claimed. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 82 USPQ2d 1385, 1396 (2007); *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also MPEP § 2141. The Office provides no explanation of why one would modify Marsh with Arsenault, as Arsenault's reduction of broadcast resources would not provide any discernable difference in the ability of the Marsh system to automatically record a particular program based on its monitoring of a user's preferences. Nor does the Office explain how to modify Marsh with Arsenault, or how such a modification would achieve the claimed invention.

For the reasons stated above, Arsenault does not compensate for the deficiencies of Marsh. The cited references taken alone or in combination do not teach, suggest, or make obvious the claimed limitations of the present invention, and Applicant respectfully requests that the rejection be withdrawn.

Obviousness Rejection over Marsh and Arsenault in view of Hoffberg

Claims 36 and 37 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Marsh and Arsenault in view of Hoffberg. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, Marsh and Arsenault are deficient as primary references, because they fail to teach or suggest each and every limitation of the independent claims, either alone or combined. Neither Marsh nor Arsenault teach or suggest a user selecting some of the "available content streams" associated with a particular program event for recording as claimed

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in the present invention. Hoffberg's alleged teaching of a modulator fails to supplement the deficiencies of Marsh and Arsenault as primary references. Hence, the cited references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicant respectfully requests that the rejection be withdrawn.

In view of the foregoing, all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this Application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative.

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